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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/687,892	10/13/2000	Phillip Koh-Kwe Hsu	74622-014	8983
21890	7590	08/20/2007	EXAMINER	
PROSKAUER ROSE LLP PATENT DEPARTMENT 1585 BROADWAY NEW YORK, NY 10036-8299			CHANDLER, SARA M	
			ART UNIT	PAPER NUMBER
			3693	
			MAIL DATE	DELIVERY MODE
			08/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/687,892	HSU ET AL.	
	Examiner	Art Unit	
	Sara Chandler	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1)☒ Responsive to communication(s) filed on 06/05/07.
- 2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.
- 3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4)☒ Claim(s) 27-46 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5)☐ Claim(s) _____ is/are allowed.
- 6)☒ Claim(s) 27-46 is/are rejected.
- 7)☐ Claim(s) _____ is/are objected to.
- 8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9)☐ The specification is objected to by the Examiner.
- 10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a)☐ All b)☐ Some * c)☐ None of:
 - 1.☐ Certified copies of the priority documents have been received.
 - 2.☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's arguments and request for continued examination of application 09/687,892 (10/13/2000) filed on 06/05/07.

Claim Interpretation

1. In determining patentability of an invention over the prior art, all claim limitations have been considered and interpreted as broadly as their terms reasonably allow. See MPEP § 2111.

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Pruter*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See MPEP § 2111.

2. All claim limitations have been considered. Additionally, all words in the claims have been considered in judging the patentability of the claims against the prior art. The following language is interpreted as not further limiting the scope of the claimed invention. See MPEP 2106 II C.

Language in a method claim that states only the intended use or intended result (e.g., "for _____"), but the expression does not result in a manipulative difference in the steps of the claim. Language in a system claim that states only the intended use or intended result (e.g., "for _____"), but does not result in a

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structural difference between the claimed invention and the prior art. In other words, if the prior art structure is capable of performing the intended use, then it meets the claim.

Claim limitations that contain statement(s) such as "*if, may, might, can could*", as optional language. As matter of linguistic precision, optional claim elements do not narrow claim limitations, since they can always be omitted.

Claim limitations that contain statement(s) such as "*wherein, whereby*", that fail to further define the steps or acts to be performed in method claims or the discrete physical structure required of system claims.

USPTO personnel should begin claim analysis by identifying and evaluating each claim limitation. For processes, the claim limitations will define steps or acts to be performed. For products, the claim limitations will define discrete physical structures or materials. Product claims are claims that are directed to either machines, manufactures or compositions of matter. See MPEP § 2106 II C.

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

See MPEP § 2106 II C.

3. Independent claims are examined together, since they are not patentable distinct. If applicant expressly states on the record that two or more independent and distinct

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inventions are claimed in a single application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 27-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt, US Pat. No. 5,893,091.

Re Claims 27-36: Hunt discloses a computer system for delivering messages for reception by a client user (Hunt, abstract, Figs. 1-12; col. 1, line 1+ - col. 16, line 16), the client user being a customer of the computer system and different from an internal user (Hunt, abstract, Figs. 1-12, col. 5, lines 27-50; col. 7, line 53+ - col. 8, line 27; col. 8, line 43+ - col. 9, line 21; col. 10, line 34 - col. 11, line 58; col. 13, lines 10-31), the internal user being a member of personnel of a proprietor of the computer system (Hunt, abstract, Figs. 1-12, col. 4, lines 38-55; col. 5, lines 5-26; col. 7, line 53+ - col. 8, line 42;

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col. 10, lines 54+ - col. 11, line 17; col. 11, line 35-48; col. 11, line 59+ - col. 12, line 62;

col. 14, line 38+ - col. 15, line 45), the computer system comprising:

at least one data storage device storing a messaging system, the messaging system comprising (Hunt, abstract, Figs. 1-12; col. 1, line 1+ - col. 16, line 16):

a registration system program configured to register the client user's preferences for messages to be received by the client user (Hunt, abstract, Figs. 1-12, col. 5, lines 27-50; col. 7, line 53+ - col. 8, line 27; col. 8, line 43+ - col. 9, line 21; col. 11, lines 35-58; col. 13, lines 10-31);

a message creation system program configured to automatically create messages in accordance with the client user's registered preferences, for delivery of the messages for reception by the client user (Hunt, abstract, Figs. 1-12, col. 4, line 38+ - col. 6, line 31; col. 7, line 53+ - col. 8, line 27; col. 8, line 43+ - col. 9, line 21; col. 9, line 40+ - col. 10, line 5; col. 10, line 33+ - col. 11, line 3; col. 11, line 35+ - col. 12, line 25; col. 12, line 45-53; col. 13, line 6+ - col. 13, line 31); and

an intervention system program configured to delay delivery of a specific message created by said message creation system in accordance with the client user's registered preferences and to enable the internal user of the system, during the delay, to at least one of add to and edit the specific message requested by the client user prior to delivery to create a modified message, wherein the message system program delivers the modified message in place of the specific message (Hunt, abstract, Figs. 1-12, col. 4, line 38+ - col. 6, line 31; col. 7, line 53+ - col. 8, line 27; col. 8, line 43+ - col. 9, line 21;

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col. 9, line 40+ - col. 10, line 5; col. 10, line 33+ - col. 11, line 3; col. 11, line 35+ - col. 12, line 25; col. 12, line 45-53; col. 13, line 6+ - col. 13, line 31).

Hunt fails to explicitly disclose wherein the message is a financial message.

Field of Use/Analogous Art: It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the problem to be solved is allowing an internal user to add to and/or edit a message before delivery to a client user in accordance with client user preferences.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Hunt to provide wherein the message is a financial message.

As suggested by Hunt, the need for managing and distributing information is applicable to a broad cross section of industries including financial, retail, rental, travel and entertainment.

Claims 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt as applied to claim 27 above, and further in view of Bove, US Pub. No. 2005/0154658.

Re Claims 34 and 35: Hunt discloses the claimed system supra but fails to explicitly disclose an internal user interface system program. Bove discloses an internal user interface system program. It would have been obvious to one of ordinary skill in

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the art at the time the invention was made to modify the teachings of Hunt by adopting the teachings of Bove to provide a system further comprising an internal user interface system program. As suggested by Bove, although automated systems related to financial and investment planning are useful for reducing what would otherwise involve a labor intensive process, there is still a need from a customer service and customer goodwill perspective to allow internal users (i.e., such as investment counselors and investment professionals) to access, monitor and modify because of the unique situations, preferences, or expectations of clients.

Claims 37-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunt, US Pat. No. 5,893,091 in view of Bove, US Pub. No. 2005/0154658.

Re Claims 37-41: Hunt discloses:

registered preferences registered by the client user for receiving automatically created messages, the messages being automatically created in accordance with the client user's registered preferences for delivery for reception by the client user (Hunt, abstract, Figs. 1-12, col. 4, line 38+ - col. 6, line 31; col. 7, line 53+ - col. 8, line 27; col. 8, line 43+ - col. 9, line 21; col. 9, line 40+ - col. 10, line 5; col. 10, line 33+ - col. 11, line 3; col. 11, line 35+ - col. 12, line 25; col. 12, line 45-53; col. 13, line 6+ - col. 13, line 31); and an intervention system configured to delay delivery of a specific message created in accordance with the client user's registered preferences and to enable the internal user of the computer system, during the delay, to at least one of add to and edit the specific message user prior to delivery to create a modified message, for delivery of the modified message for reception by the client user in place of the specific message

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(Hunt, abstract, Figs. 1-12, col. 4, line 38+ - col. 6, line 31; col. 7, line 53+ - col. 8, line 27; col. 8, line 43+ - col. 9, line 21; col. 9, line 40+ - col. 10, line 5; col. 10, line 33+ - col. 11, line 3; col. 11, line 35+ - col. 12, line 25; col. 12, line 45-53; col. 13, line 6+ - col. 13, line 31).

Hunt fails to explicitly disclose:

wherein the message is a financial message; and

an internal user interface system for an internal user of a financial message delivery system in a financial computer system, the internal user being a member of personnel of a proprietor of the computer system and different from a client user, the client user being a customer of the computer system, the interface system comprising: a first interface configured to enable the internal user to access registered preferences registered by the client user for receiving automatically created financial messages, the financial messages being automatically created in accordance with the client user's registered preferences for delivery for reception by the client user.

In regards to wherein the message is a financial message.

Field of Use/Analogous Art: It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the problem to be solved is allowing an internal user to add to and/or edit a message before delivery to a client user in accordance with client user preferences.

Bove discloses an internal user interface system for an internal user of a financial message delivery system in a financial computer system (Bove, Figs. 3A-6; [0002] [0006] [0025] [0026] [0038] [0040] [0046] thru [0061] [0088] [0101]), the internal user being a member of personnel of a proprietor of the computer system and different from a client user (Bove, Figs. 3A-6; [0002] [0006] [0025] [0026] [0038] [0040] [0046] thru [0061] [0088] [0101]), the client user being a customer of the computer system (Bove, Figs. 1A-10; abstract; [0001] thru [0116]), the interface system comprising: a first interface configured to enable the internal user to access registered preferences registered by the client user for receiving automatically created financial messages, the financial messages being automatically created in accordance with the client user's registered preferences for delivery for reception by the client user (Bove, Figs. 3A-6; [0002] [0006] [0025] [0026] [0038] [0040] [0046] thru [0061] [0088] [0101]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Hunt by adopting the teachings of Bove to provide wherein the message is a financial message; an internal user interface system for an internal user of a financial message delivery system in a financial computer system, the internal user being a member of personnel of a proprietor of the computer system and different from a client user, the client user being a customer of the computer system, the interface system comprising: a first interface configured to enable the internal user to access registered preferences registered by the client user for receiving automatically created financial messages, the financial messages being automatically created in accordance with the client user's registered preferences for

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delivery for reception by the client user;

As suggested by Bove, although automated systems related to financial and investment planning are useful for reducing what would otherwise involve a labor intensive process, there is still a need from a customer service and customer goodwill perspective to allow internal users (i.e., such as investment counselors and investment professionals) to access, monitor and modify because of the unique situations, preferences, or expectations of clients.

Re Claims 42-46: Hunt discloses a computerized method for delivering one or more messages to a client user from an internal user in a computer system, the internal user being a member of personnel of a proprietor of the computer system and different from a client user, the client user being a customer of the computer system, the method comprising:

registered preferences registered by the client user for receiving automatically created messages, the messages being automatically created in accordance with the client user's registered preferences for delivery for reception by the client user (Hunt, abstract, Figs. 1-12, col. 4, line 38+ - col. 6, line 31; col. 7, line 53+ - col. 8, line 27; col. 8, line 43+ - col. 9, line 21; col. 9, line 40+ - col. 10, line 5; col. 10, line 33+ - col. 11, line 3; col. 11, line 35+ - col. 12, line 25; col. 12, line 45-53; col. 13, line 6+ - col. 13, line 31);
delaying delivery of a specific message created in accordance with the client user's registered preferences (Hunt, abstract, Figs. 1-12, col. 4, line 38+ - col. 6, line 31; col. 7, line 53+ - col. 8, line 27; col. 8, line 43+ - col. 9, line 21; col. 9, line 40+ - col. 10, line 5; col. 10, line 33+ - col. 11, line 3; col. 11, line 35+ - col. 12, line 25; col. 12, line 45-53;

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col. 13, line 6+ - col. 13, line 31); and

enabling during the delay, through an intervention system usable by the internal user, at least one of addition to and editing of the specific message user prior to delivery to create a modified message, for delivery of the modified message for reception by the client user in place of the specific message (Hunt, abstract, Figs. 1-12, col. 4, line 38+ - col. 6, line 31; col. 7, line 53+ - col. 8, line 27; col. 8, line 43+ - col. 9, line 21; col. 9, line 40+ - col. 10, line 5; col. 10, line 33+ - col. 11, line 3; col. 11, line 35+ - col. 12, line 25; col. 12, line 45-53; col. 13, line 6+ - col. 13, line 31).

Hunt fails to explicitly disclose:

wherein the message is financial message and wherein the computer system is a financial computer system.

providing, through a first interface usable by the internal user, registered preferences registered by the client user for receiving automatically created financial messages, the financial messages being automatically created in accordance with the client user's registered preferences for delivery for reception by the client user;

In regards to wherein the message is financial message and wherein the computer system is a financial computer system.

Field of Use/Analogous Art: It has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the problem to be solved is allowing an

internal user to add to and/or edit a message before delivery to a client user in accordance with client user preferences.

Bove discloses:

providing, through a first interface usable by the internal user, registered preferences registered by the client user for receiving automatically created financial messages, the financial messages being automatically created in accordance with the client user's registered preferences for delivery for reception by the client user (Bove, Figs. 3A-6; [0002] [0006] [0025] [0026] [0038] [0040] [0046] thru [0061] [0088] [0101]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Hunt by adopting the teachings of Bove to provide a computerized method further comprising wherein the message is financial message and wherein the computer system is a financial computer system; and providing, through a first interface usable by the internal user, registered preferences registered by the client user for receiving automatically created financial messages, the financial messages being automatically created in accordance with the client user's registered preferences for delivery for reception by the client user.

As suggested by Bove, although automated systems related to financial and investment planning are useful for reducing what would otherwise involve a labor intensive process, there is still a need from a customer service and customer goodwill perspective to allow internal users (i.e., such as investment counselors and investment professionals) to access, monitor and modify because of the unique situations, preferences, or expectations of clients.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following references relate to financial advising, planning etc. ("5220500"|"5819263"|"5864828"|"6154732"|"6347307"|"6970843"|"7089202"|"7110981"|"7149713"|"7165044"|"7177831"|"7197484").PN.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Chandler whose telephone number is 571-272-1186. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SMC


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PRIMARY EXAMINER